

**Amendments to the Drawings:**

Figure 4 has been amended to correct minor informalities.

### **REMARKS**

Claims 1 and 3-6 are pending. Reconsideration and allowance of the present application based on the following remarks are respectfully requested.

#### ***In the Drawings***

Figure 4 was objected to for minor informalities. Applicants have amended Figure 4 in accordance with the Examiner's suggestion. Replacement sheets will be filed upon issuance of Notice of Allowance. Accordingly, Applicant respectfully submits that this objection is moot.

#### ***Claim Rejections Under 35 U.S.C. § 103***

Claims 1-6 were rejected under 35 U.S.C. § 103(a) over Barna (U.S. Publication No. 2002/0046277) in view of Madour (U.S. Publication No. 2003/0053431). Applicants initially note that claim 2 had been cancelled. Accordingly, Applicants respectfully submit that the rejection of claim 2 is moot. Applicants respectfully traverse the rejection of the other five claims.

Claim 1 recites, in part, a method for performing a hard handoff that includes setting up a channel link passing through a target base station controller (T-BSC) associated with a target-PDSN (T-PDSN), a source base station controller (S-BSC) associated with a source-PDSN (S-PDSN), a source packet control function (S-PCF) and the S-PDSN by establishing a channel link between the S-BSC and the T-BSC via a mobile station center (MSC) in an active packet session mode. The Examiner states that Barna "clearly suggest[s] and anticipate[s] a channel link passing through the T-BSC associated with the T-PDSN, the S-BSC associated with the S-PDSN, the S-PCF and the S-PDSN." Applicants respectfully disagree.

The Examiner cites to Figure 2 and paragraph [0016] to demonstrate the presence of the above element. However, the above portions of Barna do not disclose any channel link passing through a T-BSC and a S-BSC. Paragraph [0016] of Barna states that a "MS is handed off from a first PDSN (PDSN-1) ... to a second PDSN (PDSN-2)." Paragraph [0016] goes on to state that the Barna invention includes "a tunneling setup mechanism that that establishes a data tunnel between PDSN-1 and PDSN-2, and passes data from PDSN-1 through the data tunnel to the MS during the handoff procedure." Paragraph [0016] nowhere discloses that a channel link passes through the T-BSC and the S-BSC. In fact, paragraph [0016] does not even mention the presence of a T-BSC or S-BSC.

Figure 2 is equally unavailing. The Examiner directs the Applicants to “see the link passing through the target-BSC 64, the source-BSC 61, the source PCF 62, the source-PDSN 63, the target-PDSN 66” in figure 2. (Office Action at p. 6). Notably, there is not a single signal sent to or from the Source BSC 61 or the Target BSC 64 in Figure 2, let alone a link passing through the Source BSC 61 and the Target BSC 64. Paragraph’s [0039] to [0044] discusses the active mode inter-PDSN handoff of Figure 2. Notably, other than a statement that there is a source BSC and target BSC, para. [0039], no reference is made to a BSC anywhere in the discussion. Further, Barna explicitly discloses that, during the handoff, several connections are made: connections 71 and 72 between the PDSN 1 and PDSN 2, connection 67 between the MS, the source PCF and the target PCF, and connection 75 between the PDSN 2 and the target PCF. The two BSCs take no part in the handoff procedure. Applicants respectfully submit that the Examiner’s assertion that the T-BSC and S-BSC form part of a channel link at any time during a handoff procedure is disingenuous considering the lack of any suggestion of such in Barna. *See Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (“In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art”) (emphasis in original).

Further, Madour does not cure the above-referenced deficiency of Barna. The Examiner alleges that Madour discloses a “channel link passing between the Target BSC and Source BSC” in Fig. 2. First, a “handoff required” signal and a “handoff request” signal do not together constitute a “channel,” as required by claim 1. The BSC-S sends one signal (Handoff required) to the MSC. The MSC sends a completely different signal (Handoff request) to the BSC-T. No network traffic or data is being transferred from the BSC-S to the BSC-T. No “channel” is established under even the broadest reasonable interpretation of the word. *See* MPEP 2111. Merely sending different signals in succession clearly cannot constitute a link. Further, Madour explicitly discloses that the traffic path 28 (i.e., the channel) comprises connections between the BSC-T and the PCF-T 25 (29a) and the PCF-T 25 and the PDSN 27 (29b). (Para. [0029]). No traffic ever flows through a link passing between the Target BSC and the Source BSC, because there is no such link.

Accordingly, no combination of Barna and Madour teach or suggest, a method for performing a hard handoff that includes setting up a channel link passing through a target base station controller (T-BSC) associated with a target-PDSN (T-PDSN), a source base station

controller (S-BSC) associated with a source-PDSN (S-PDSN), a source packet control function (S-PCF) and the S-PDSN by establishing a channel link between the S-BSC and the T-BSC via a mobile station center (MSC) in an active packet session mode, as recited in claim 1.

Further, the Applicants respectfully submit that the motivation to combine Barna and Madour provided by the Examiner is improper. Although the Examiner recognizes that "obviousness can only be established ... where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art," (Office Action at p. 3), the Examiner nevertheless does not support the rejection of claim one with reference to any teaching, suggestion or motivation in the prior art. The Examiner states, without support in either Barna or Madour, that combining Barna and Madour would result in a more efficient system, because there would be a single center for handoff, rather than duplicate circuits. However, the Examiner neglects to note that Barna explicitly requires that there exist a tunnel between PDSN 1 and PDSN 2, so that the volume of data transferred can be easily monitored. (Abstract). Accordingly, modifying Barna to instead include an MSC as part of the channel link goes against the express teachings of Barna, and would render Barna unsuitable for its intended purpose, or at the least alter the principle of operation of Barna. (MPEP 2143.01(V-VI)). As a result, the Examiner has failed to provide a proper *prima facie* case of obviousness with respect to claim 1.

Claims 3-6 are believed allowable for at least the same reasons presented above with respect to claim 1 by virtue of their dependence upon claim 1. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection.

### **Conclusion**


Therefore, all objections and rejections having been addressed, it is respectfully submitted that the present application is in a condition for allowance and a Notice to that effect is earnestly solicited.

Should any issues remain unresolved, the Examiner is encouraged to contact the undersigned attorney for Applicants at the telephone number indicated below in order to expeditiously resolve any remaining issues.

Application No. 10/026,826  
*Amendment dated December 21, 2006.*  
Page 8

Respectfully submitted,

MAYER BROWN ROWE & MAW LLP

By:   
Yoon S. Ham  
Registration No. 45,307  
Direct No. (202) 263-3280

YSH/NAH

Intellectual Property Group  
1909 K Street, N.W.  
Washington, D.C. 20006-1101  
(202) 263-3000 Telephone  
(202) 263-3300 Facsimile

Date: December 21, 2006